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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,430

02/22/2006

Maria-Elena Ferreira

1169-035

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20529

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04/27/2009

THE NATH LAW GROUP

112 South West Street

Alexandria, VA 22314

EXAMINER

AULAKH, CHARANJIT

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

04/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,430	Applicant(s) FERREIRA ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-51 is/are pending in the application.
- 4a) Of the above claim(s) 23-25,30,31,42 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,26-29,32-41,45 and 49-51 is/are rejected.
- 7) ☒ Claim(s) 43 and 46-48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. According to paper filed on March 4, 2009, the applicants have elected group II with traverse for further prosecution. The applicants have also amended claims 23-36, 38-45 and 47 and furthermore, have added new claims 49-51.

2. Claims 22-51 are pending in the application. Claims 23-25, 30, 31, 42 and 44 are withdrawn from further consideration as being directed to non-elected invention.

Response to Arguments

3. Applicant's arguments filed on March 4, 2009 have been fully considered but they are not persuasive. The examiner does not agree with the applicants arguments that canthin-6-one ring structure is the common core represented by formula (I) in which R1-R8 are all H. The applicants are reminded that in the compound claims (see claim 37), R1-R8 can not represent H at the same time when n is 0. There are numerous provisos in compound claims to exclude prior art compounds (see claim 37) encompassed by formula (I) and therefore, the scope of compound claims and method claims is different. In order to keep compound claims together with method of treatment using same compounds, the restriction requirement is proper since even within the elected group II, there are numerous prior art compounds (over 100 references) as will be evidenced

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later on by prior art rejection of instant compounds directed to the elected group. Thus, restriction requirement as indicated is proper and thereby made final.

Specification

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

5. The disclosure is objected to because of the following informalities: There is no brief description of drawings present in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 22, 26-29, 32-41, 45 and 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 22 and 37, the values of variables R1-R8 defined as ---- secondary or tertiary alkylamide ----- is listed twice in both the claims.

In independent claims 22 and 37, the value of variables R1-R8 defined as ---C2 heterocyclic group ---- is indefinite since such heterocyclic groups are not known to be present in the prior art.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 37, 38, 45, 46, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Ma (Phytochemistry).

Ma discloses Alkaloids and phenylpropanoids. The compounds 1 and 2 (see page 1077) disclosed by Ma anticipate the instant claims when R4 represents an alkyl group in the instant compounds of formula (I).

8. Claims 37-42 45, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson (Aus. J. of Sci. Res.).

Nelson discloses alkaloids from the Australian rutaceae. The compounds (I), (II), (V) and (VI) disclosed by Nelson (see pages 771 and 772) anticipate the instant claims when R3 and/or R4 represents –OH, alkylthio or halogen in the instant compounds of formula (I).

9. Claims 22, 26-29, 32-41, 45, 46 and 48-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitscher (Heterocycles).

Mitscher discloses antimicrobial agents from higher plants. The compounds disclosed in canthine family on pages 7-8 (references 7 and 9-13) as well as compounds 5-7 and 17 (see page 12) by Mitscher anticipate the instant claims when R3 and/or R4 represent hydroxyl, methoxy, SMealkyl, carboxylic acid, amide or alkylester group in the instant compounds of formula (I).

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10. Claims 37-41, 45, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Omoto (JP 02004790).

Omoto discloses antiulcer alkaloids. The compounds of formula (I) disclosed by Omoto anticipate the instant claims when R3 and/or R4 represent hydroxyl or methoxy group in the instant compounds of formula (I).

11. Claims 22, 26-29, 32-41 and 45-49 are objected for containing non-elected subject matter.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charanjit S. Aulakh/
Primary Examiner, Art Unit 1625